

REMARKS

Claims 1-48 are currently pending in this application. By this Response, claim 1 is amended to recite a method in a data processing system. No new matter has been added by the amendment to claim 1. Reconsideration of the claims in view of the following remarks is respectfully requested.

I. Response to Restriction

The Office Action alleges that there are three separate and distinct inventions recited in the claims. The inventions are allegedly recited in the following grouping of claims:

- I. Claims 1-20, drawn to a method and classified in a class 705, subclass 26;
- II. Claims 21-40, drawn to a computer program product and classified in class 705, subclass 26;
- III. Claims 41-48, drawn to an apparatus and classified in class 705, subclass 26.

Applicants hereby elect **Group I, claims 1-20** with traverse. Applicants respectfully submit that a proper restriction requirement must meet a two-prong test. First, the Examiner must show that the claims include two or more inventions, the two or more inventions are able to support separate patents, and the two or more inventions are either independent or distinct. Second, the Examiner must show that it is a serious burden on the Examiner to examine all of the claims even though they may be directed to independent or distinct inventions. Applicants respectfully submit that the Examiner has failed to establish his burden under either the first prong or the second prong of the test.

In the restriction requirement, the Examiner states that the reason why alleged invention I is distinct from inventions II and III is because invention I may be performed by hand and thus, may be performed by a different process than that recited in the computer program product and apparatus claims. By this Response, claim 1 is amended

to recite "A method, in a data processing system, for...". Thus, the possibility of the method being performed by hand is no longer a viable option since the claim specifically states that it is a method performed "in a data processing system." Furthermore, the Examiner has failed to show any other apparatus or computer program product that may implement the method of claims 1-20 or that the apparatus and computer program product of Groups I and II may implement methods other than that of claims 1-20. Therefore, Applicants respectfully submit that the Examiner has failed to establish his burden of showing separately patentable and distinct inventions.

With regard to the second prong of the test, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.
(emphasis added)

Applicant respectfully submits that it is not a burden on the Examiner to search all of claims 1-48 even though the Examiner believes some claims to be directed to independent or distinct inventions. This lack of burden on the Examiner is clear from the very fact that the Examiner has admitted that all of the claims are classified in the same class and subclass, i.e. class 705, subclass 26. Thus, the claims are all directed to the same technology area, even if they may be directed to separately patentable or distinct inventions. Thus, any examination of one group of claims would necessarily cover the same areas of examination as the other groups of claims.

This lack of burden on the Examiner is further exemplified by the parallel claims in each of the groups that the Examiner alleges are directed to separate and distinct inventions. Taking independent claims 1, 21 and 41 as exemplary, these claims recite:

1. A method, in a data processing system, for making purchasing decisions for purchasing a product or service, comprising:
 - obtaining, in the data processing system, one or more rules identifying strategic purchasing policies;
 - obtaining, in the data processing system, one or more attributes for the product or service to be purchased; and
 - automatically making a decision, in the data processing system, to purchase the product or service from a vendor based on the one or more

rules and the one or more attributes.

21. A computer program product in a computer readable medium for making purchasing decisions for purchasing a product or service, comprising:

- first instructions for obtaining one or more rules identifying strategic purchasing policies;
- second instructions for obtaining one or more attributes for the product or service to be purchased; and
- third instructions for automatically making a decision to purchase the product or service from a vendor based on the one or more rules and the one or more attributes.

41. An apparatus for making purchasing decisions for purchasing a product or service, comprising:

- a first storage device for storing one or more rules identifying strategic purchasing policies;
- a second storage device for storing one or more attributes for the product or service to be purchased; and
- a controller coupled to the first storage device and the second storage device, wherein the controller automatically makes a decision to purchase the product or service from a vendor based on the one or more rules and the one or more attributes.

With the exception of these claims being directed to a method in a data processing system (claim 1), a computer program product (claim 21) and an apparatus (claim 41), the language of the claims is virtually identical. The only difference between claim 1 and claim 21 is that one recites the method (claim 1) and the other recites the "instructions for" of a computer program product (claim 21). If the Examiner searches the method claims of group I, it would not be a burden on the Examiner to search "instructions for" performing the method steps of the claims of group I. This is especially true since most of the references found in a search of the method claims of the present invention would almost certainly teach an implementation of a method in a computer program product having "instructions for" implementing the method. It is very unlikely that the addition of the words "instructions for" before the method steps causes a "serious burden" on the Examiner to examine claims 21-40.

The only difference between claim 1 and claim 41 is that claim 41 recites a first storage device, a second storage device and a controller. Similar to the differences

between claims 1 and 21 above, these features are not sufficient to raise the burden on the Examiner to the level of a "serious burden" when examining these claims along with claims 1-20. In other words, it would not be a serious burden on the Examiner to search for a storage device and a controller when examining the invention recited in claims 1-20 of Group I. Furthermore, claims 42-48 recite similar features to that of claims 9-12, 14-16 and 19 of Group I and claims 29-32, 34-36 and 39 of Group II and likewise, would not raise a serious burden on the Examiner with regard to examining these claims along with those claims of Groups I and II.

Thus, the Examiner has failed to establish either of the first or second prongs of the two pronged test for establishing a proper restriction requirement. Therefore, Applicants respectfully submit that the restriction requirement is improper and should be withdrawn. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn and the Examiner examine all of pending claims 1-48.

II. Election of Species

The Restriction Requirement indicates that the claims are directed to different species of invention as follows:

Group I:

- Species IA: claims 1-5, 8-20;
- Species IB: claims 1-4, 6, 8-20; and
- Species IC: claims 1-4, 7-20.

Group II:

- Species IIA: claims 21-25, 28-40;
- Species IIB: claims 21-24, 26, 28-40; and
- Species IIC: claims 21-24, 27-40.

Group III:

- Species IIIA: claims 41, 42, 43, 47 and 48;

Species IIIB: claims 41, 42, 44, 47 and 48;

Species IIIC: claims 41, 42, 45, 47 and 48; and

Species IIID: claims 41, 42, 46, 47 and 48.

Applicants hereby elect **Species IA, claims 1-5 and 8-20** within **Group I** with traverse. Again, while the Examiner may believe that certain claims are directed to a different species of invention, the Examiner has failed to establish any burden with regard to examining all of the alleged species of invention. In fact, there is no burden on the Examiner to examine all of the claims. This is evident even in the very grouping of claims into the various alleged species. For example, of the 20 claims in Group I, the Examiner basically separates out 3 claims as being directed to separate species with the remaining 17 claims being present in all of the alleged species. The 3 claims are claims 5, 6 and 7 which recite the features of one or more attributes being dynamically set (claim 5), the one or more attributes being fixed (claim 6) and at least one of the one or more attributes is dynamically set and at least one of the one or more attributes is fixed (claim 7).

It is first noted that all of the 3 claims at issue are dependent claims from independent claim 1 and merely recite further aspects of features recited in claim 1. The Examiner has failed to show where searching all of these claims results in a "serious burden" on the part of the Examiner. Applicants respectfully submit that it would not be a burden on the Examiner to examine the features of dynamically set attributes and fixed attributes along with the features of claim 1 since such a search would be encompassed by the search of claim 1, i.e. the broader independent claim. Similarly, the various alleged "species" are set forth with regard to Group II and the election requirement with regard to these species is traversed for similar reasons as set forth above.

With regard to the alleged "species" in Group III, it is noted that the only difference between the species is claims 43, 44, 45 and 46, i.e. claims 41, 42, 47 and 48 appear in each of the alleged "species." It is also noted that claims 43, 44, 45 and 46 recite similar features to those of claims 10, 12, 14 and 15 of Group I and claims 30, 32, 34 and 35 of Group II. However, there was no election of species with regard to claims 10, 12, 14, 15, 30, 32, 34 and 35. Why in one Group are these claim features regarded as

being separate species and yet in another they are not? The answer is that they are not separate species in any of the Groups and there is no burden on the Examiner to examine these claims as admitted by the Examiner in his including claims 10, 12, 14, 15, 30, 32, 34 and 35 with each other and the independent claims 1 and 21 in the setting forth of alleged species in Groups I and II. Thus, again, the Examiner has failed to show any reason why these claims should be separated out from the others and Applicants should be forced to go to the time and expense to file separate applications to pursue these claims.

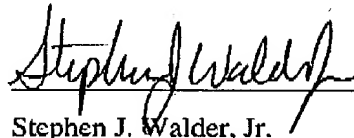
Thus, in view of the above, Applicants again respectfully submit that there is no burden on the Examiner to examine all of the claims as they now stand in this single application. Furthermore, the Examiner has failed to show any burden on his part, let alone a "serious burden" as is required under the MPEP. Accordingly, Applicants respectfully request withdrawal of the election of species requirement and examination of all alleged "species" and all allegedly "distinct" inventions recited in claims 1-48.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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